


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) BB.124		
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature <u>N/A - filed via EFS</u> Typed or printed name _____		Application Number 10/581,727 First Named Inventor Martin Krause et al. Art Unit 1652		Filed September 14, 2005 Examiner Mohammad Y. Meah, Ph.D.
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.				
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>45,332</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature Frank C. Eisenschien, Ph.D. Typed or printed name (352)375-8100 Telephone number September 7, 2010 Date		
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.				
<input type="checkbox"/> *Total of _____ forms are submitted.				

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner : Mohammad Y. Meah, Ph.D.
Art Unit : 1652
Applicants : Martin Krause, Christian Scheler, Ulrike Bottger, Hardy Weisshoff,
Michael Linscheid
Serial No. : 10/518,727
Filed : September 14, 2005
Conf. No. : 1308
For : Method and Reagent for Specifically Identifying and Quantifying One or
More Proteins in a Sample

REASONS FOR REQUEST FOR REVIEW

1. The rejection of claims 1-6, 8, 22 and 24-38 are rejected under 35 U.S.C. § 103(a) as obvious over Aebersold *et al.* (WO 00/11208) in view of Moutiez *et al.* (1997) and Li *et al.* (1997) fails to establish a *prima facie* case of obviousness because each of the limitations of the claims is not taught.

A. The claims utilize a reagent (A,Y, PRG) that is not isotopically labeled (see currently pending claim 1).

B. The Office Action admits that Aebersold *et al.* fails to teach the claimed reagent in the Office Action dated August 4, 2009 at page 5 (last sentence), Office Action dated March 4, 2010 at page 4, lines 10-12, Office Action dated July 8, 2010 at page 3, lines 13-15.

C. Moutiez *et al.* (1997) and Li *et al.* (1997) fail to teach reagents meeting this limitation and are directed to other elements of the claims (DOTA-chelated lanthanide metals; Moutiez *et al.*) and Gd³⁺-labeled DOTA chelates (Li *et al.*).

D. Thus, the combined teachings of Aebersold *et al.* (WO 00/11208), Moutiez *et al.* (1997) and Li *et al.* (1997) fail to establish a *prima facie* case of obviousness because each of the limitations of the claims is not taught.

2. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). There is no suggestion or motivation to make the modification proposed in the Office Actions to the teachings of Aebersold *et al.*

- A. The Office Actions have argued that one skilled in the art would have been motivated to alter the teachings of Aebersold *et al.* to use reagents that were not isotopically labeled in combination with metal ions chelated in DOTA in order to identify and quantify proteins (see August 4, 2009 at page 6 (third paragraph), Office Action dated March 4, 2010 at page 5, paragraph 1, Office Action dated July 8, 2010 at page 4, first full paragraph).
- B. Aebersold *et al.* describe isotope coded affinity tag (ICAT) technology. As discussed in the as-filed specification (see page 4, line 18 through page 5, line 27), ICAT technology relies on (and requires) the use of isotopes in order to allow for the quantification and identification of biological molecules labeled via ICAT technology. ICAT technology is fundamentally different from the present invention (and thus is not similar).
- C. Modification of the ICAT reagents taught in Aebersold *et al.* (as argued in the Office Actions) would have rendered Aebersold's reagents unsuitable for their intended purpose because the reagents would not have contained the isotopes that allow one to quantify and identify of biological molecules.

3. The obviousness rejection of record is the result of improper hindsight reconstruction of the claimed invention. A fact finder should be aware of the distortion caused by hindsight bias. *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007) and "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR*, 127 S.Ct at 1741.

- A. As discussed above and admitted in the Office Actions, the use of reagents containing no isotopes (even if chelated metals are present) is neither disclosed nor proposed by Aebersold *et al.* In fact, Aebersold *et al.*'s actual analysis is

based on the use of isotopes “integrated” into the reagents used in the methods taught by the reference. Thus, in order to arrive at the present invention, starting from Aebersold *et al.*, the person of skill had to:

- 1) disregard the main technical feature of Aebersold *et al.*, namely the tagging of biological molecules using differentially isotopically labeled reagents (without a chelator being involved) and create reagents that were not isotopically labeled,
- 2) add and permanently include a chelator into the L-group of Aebersold *et al.*, and
- 3) include a lanthanide metal ion as the label (see Response filed June 4, 2010 at pages 8-9).

In the absence of the claimed invention, there is no motivation in Aebersold *et al.* to modify the A-L-PRG-affinity tagged protein reactive reagents in *any* of the three ways as described above and none of the additional references teach or suggest the modification of Aebersold *et al.* in such a fashion. Thus, the Office Actions have engaged in improper hindsight reconstruction of the claimed invention.